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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION - WEST BLDG.
WINTON HILL BUSINESS CENTER - BOX 412
6250 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

MICHALSKI, SEAN M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,541
Filing Date: March 11, 2004
Appellant(s): GRAY ET AL.

Kevin C. Johnson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/21/2007 appealing from the Office
action mailed 07/09/2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,276,061	Rozenkranc	8-2001
5,533,263	Gilder	9-1996
6,598,303	Bosy et. al (Bosy, herein)	7/2003
3,934,338	Braginetz	1-1976
5,678,485	Shurtleff et al. (Shurtleff herein)	11-1997
D446,884 S	Kohring	8-2001
2003/0217469	Coffin	11-2003
5,787,586	Aprille Jr. et al. (Aprille herein)	8-1998

- askoxford.com. "End". 4/2/2007.
- infoplease.com. "End" . Definition from Infoplease online dictionary.
4/2/2007
- "Platinum Mach 14". SNL Archives | Episode 25.18. May, 6 2000.
<http://snl.jt.org/ep.php?i=0005060>. (Last updated 05/09/05)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 2, 3, and 5-15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

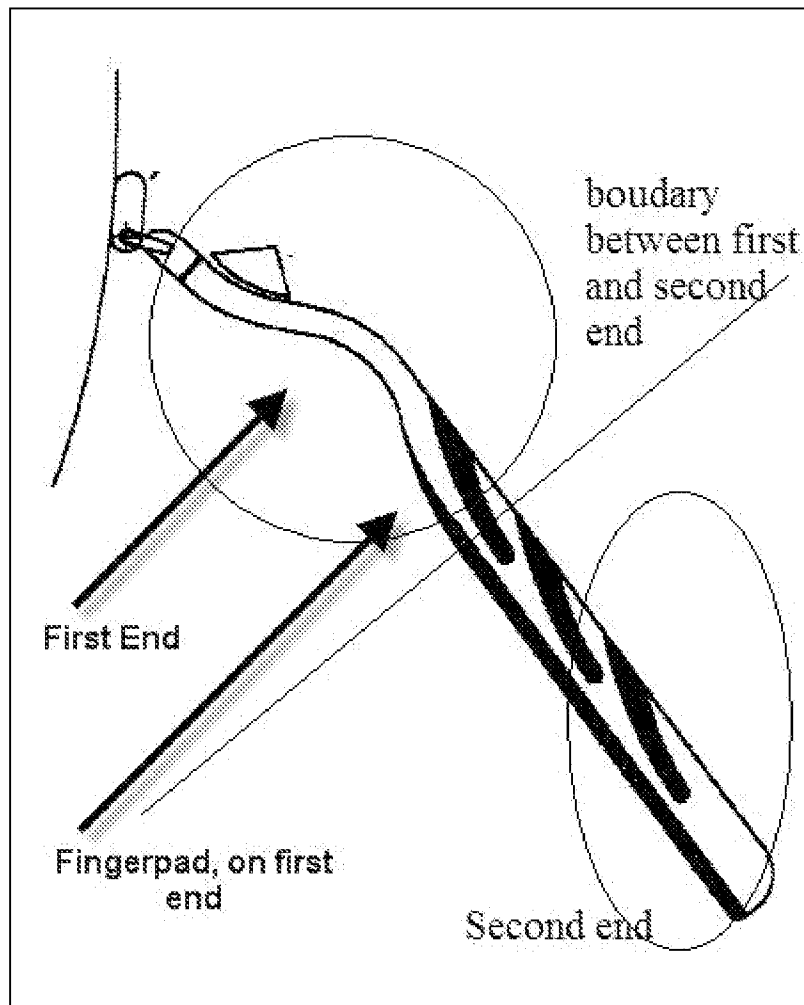
The terms “a first end” (claim 2 line 7; claim 3 line 7), “said first end” (claim 2 line 8, claim 3 line 8, claim 5 lines 1 and 2, claim 6 lines 1 and 2, claim 13 lines 1 and 2) and “the first end” (claim 15 line 2) are indefinite. The pad is (from the figures) located *near* the terminus, but not actually on the terminus of the handle, whereas the cartridge housing does connect at the actual terminus. Likewise in claim 3, the two portions do not join at the first terminus, they join adjacent the first terminus as seen in the figures. This divergent meaning (terminus versus near-terminus) reflected in the claim is indefinite. Additionally, the definition appellant is attempting to use for the word end (‘near the terminus’ or ‘near the terminal point plane or line’ “near the termination”) is indefinite in and of itself, since one of ordinary skill in the art would not know whether a button lying at 5%, 10% or 20% constituted being “at a first end”. Using the plain meaning ‘near the terminus’ renders the claim indefinite since it fails to provide notice to one of ordinary skill in the art what would infringe the claim as so construed.

2. Claims 2, 9/2, 12/2, 13/2 and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rozenkranc (USPN 6,276,061).

Regarding claim 2, Rozenkranc discloses a shaving razor (figure 2) with a housing (2 figure 1) having a primary guard (6, and the area thereby, figure1) a primary

cap (5 figure 1) . Rozenkranc further discloses primary razor blades located between the cap and guard. Rozenkranc further discloses a trimming blade (4 figure 1) mounted at the back of the housing (as seen in figure 1) , and having it's cutting edge oriented away from said upper surface (seen in figure 1). Rozenkranc further discloses an elongate handle (1 figure 2) having a curve at the first end concave on the same side as primary blades (figure 2). Rozenkranc further discloses a finger pad at said first end , on the same side as said primary blades (see figure below). This interpretation is consistent with the broadest reasonable interpretation standard which must be applied to all claim language.

Additionally, in the alternative, in response to appellants contention that a 'pad' need not be elastomeric (page 6 of remarks, fourth paragraph, submitted 06/05/2007), **Examiner would like to advance the following position: that the actual terminus of the handle Rozenkranc constitutes a 'pad' since 'finger pad' may mean *any surface that a finger is capable of resting upon*. A user is capable of resting their finger on the handle of Rozenkranc up to and including the juncture where it is combined and joined with the cartridge connecting portion, and therefore the *very terminus* of the handle of Rozenkranc on the same side as the primary blades may rightly be construed as a 'finger pad' since it is capable of acting as such and additionally, it is reasonable to believe that a user *would* use it as such.**



Regarding claim 9/2, Rozenkranc further discloses that there be three primary blades. ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

Regarding claim 12/2, Rozenkranc further discloses that the housing is pivotably connected to the handle by a connection that has an at rest stop position to prevent

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pivoting of said housing when said trimming blade is cutting hair (column 1 lines 63-67, continuing to column 2 line 1). ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

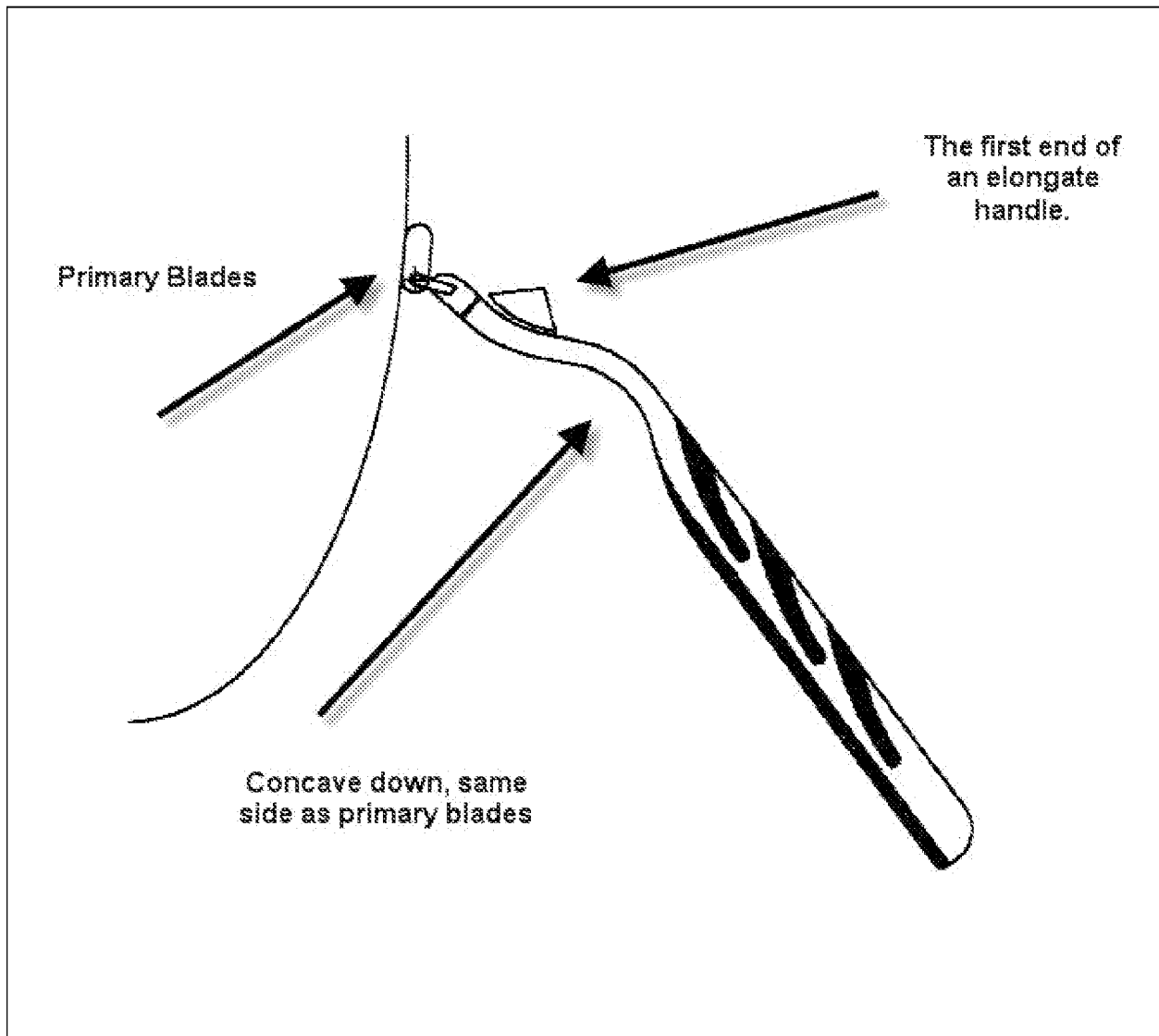
Regarding claim 13/2 there is clearly a curve at said first end which is concave on the same side as the primary blades. See above. ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

Regarding claim 14, the finger pad of Rozenkranc is oval in shape. It appears to be oval in the figure. Alternatively, see the 103(a) rejection of claim 14 below. ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

3. Claims 3, 5, 6, 9/3, 12/3, 13/3 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Gilder (USPN 5,533,263).

Regarding claim 3, Rozenkranc teaches a shaving razor (figure 2) with a housing (2 figure 1) having a primary guard (6, and the area thereby, figure 1) a primary cap (5 figure 1) . Rozenkranc further teaches a primary razor blades located between the cap and guard. Rozenkranc further teaches a trimming blade (4 figure 1) mounted at the back of the housing (as seen in figure 1) , and having it's cutting edge oriented away from said upper surface (seen in figure 1). Rozenkranc further teaches an elongate

handle (1 figure 2) having a curve at the first end concave on the same side as primary blades (figure 2, as reproduced for clarity below)



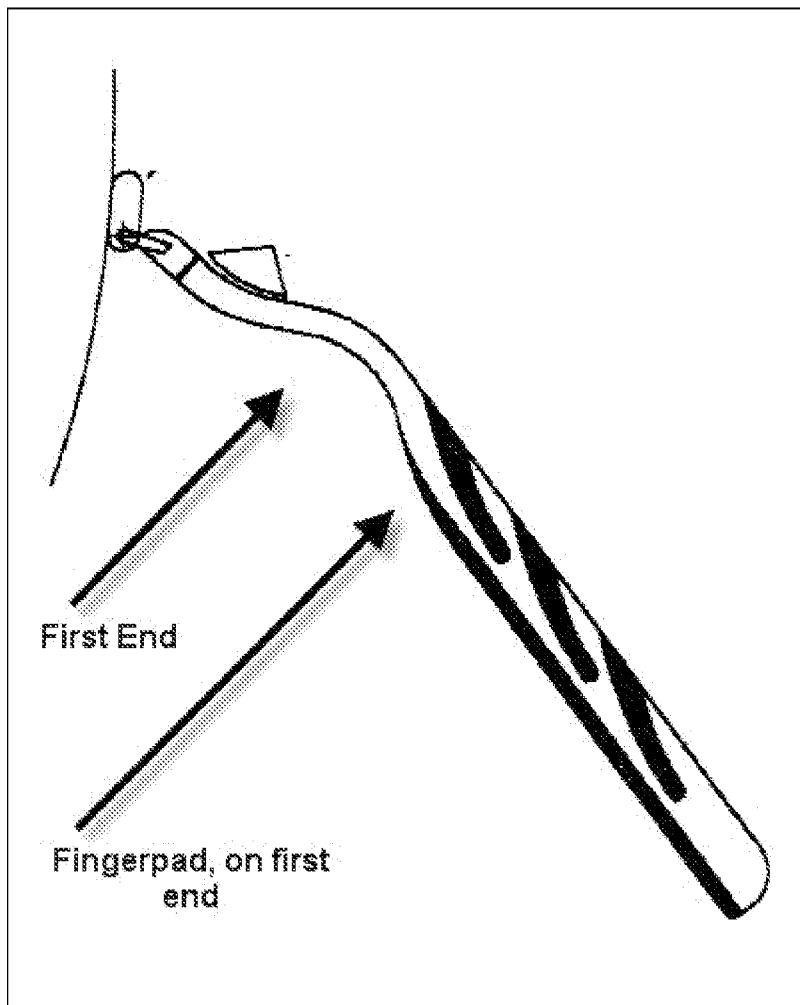
Rozenkranc does not teach a bifurcated handle at said first end.

Gilder teaches a handle that is bifurcated such that there is a region between the two portions. **The first end of Gilder is the half of the handle seen to be closest to the blade cartridge (figure 5)**, the bifurcation of Gilder is seen to be 'adjacent' the first end. The bifurcation is joined at (within) the first end (See figures 2 and 5). Furthermore,

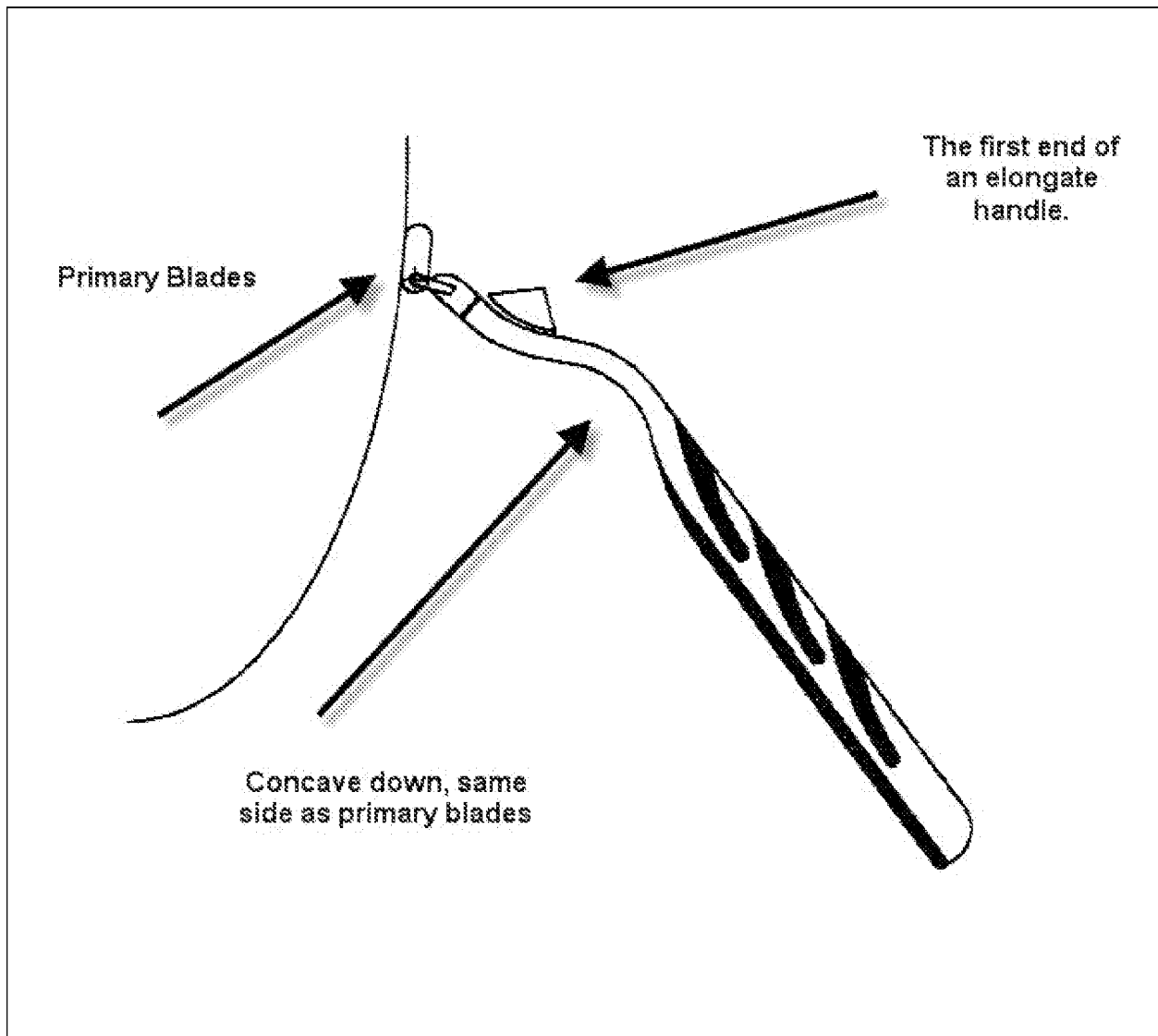
at the termination point of the first end, the bifurcation is joined. The 'region' is enclosed by the two portions. The two portions are joined "at the first end" via each element 22 figure 2. The portions enclose a region regardless of the presence of a cartridge, as seen in figure 5, the two portions enclose a region (which means they set the boundary of a region). One viewing the two portions 26 alone would say that they enclose a region. This interpretation is consistent with the broadest reasonable interpretation standard.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc by making the handle bifurcated as taught by Gilder, so the user could better view the shaving operation, or to allow a configuration "so as not to obstruct flow of rinsing water through the blade unit" (column 1 lines 37-38). The motivation to combine is that a bifurcated handle is easier to rinse.

Regarding claim 5, Rozenkranc further teaches a finger pad at said first end , on the same side as said primary blades (see figure below). ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***



Regarding claims 6, 13/3 and 15 Rozenkranc teaches a shaving razor (figure 2) with a housing (2 figure 1) having a primary guard (6, and the area thereby, figure1) a primary cap (5 figure 1) . Rozenkranc further teaches a primary razor blades located between the cap and guard. Rozenkranc further teaches a trimming blade (4 figure 1) mounted at the back of the housing (as seen in figure 1) , and having its cutting edge oriented away from said upper surface (seen in figure 1). Rozenkranc further teaches an elongate handle (1 figure 2) having a curve at the first end concave on the same side as primary blades (figure 2, as reproduced for clarity below).



Rozenkranc does not teach a bifurcated handle at said first end.

Gilder teaches a handle that is bifurcated such that there is a region between the two portions.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc by making the handle bifurcated as taught by Gilder, so the user could better view the shaving operation, or to allow a

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configuration “so as not to obstruct flow of rinsing water through the blade unit” (column 1 lines 37-38). Since in the combination the bifurcation comes together opposite the cartridge at the first end of the handle it would be proximal to the finger pad. The motivation to combine is that a bifurcated handle is easier to rinse. ***These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.***

Regarding claim 9/3, Rozenkranc further teaches the use of three primary blades. ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

Regarding claim 12/3, Rozenkranc further teaches that the housing is pivotably connected to the handle by a connection that has an at rest stop position to prevent pivoting of said housing when said trimming blade is cutting hair (column 1 lines 63-67, continuing to column 2 line 1). ***This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.***

4. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc (as applied to claim 2), or alternatively, Rozenkranc in view of Gilder (as applied to claim 5).

Regarding claim 7, all the limitations of claims 2,4, or 5 have been met as discussed above, except Rozenkranc is silent as to whether or not said finger pad is made of “elastomeric material”.

Examiner previously took official notice that the use of elastomeric material is well known in the art for use as a finger pad, for grip comfort and control **which was not challenged by appellant**. Having not been challenged the official notice has come to be considered as an admission on the record. It would have been obvious to one skilled in the art at the time of the invention to make the finger pad from an elastomeric material to make the grip comfortable and easy to control.

This claim stands or falls by its dependence on claims 2 and/or 3, as noted in the appeal brief.

5. Claims 8/2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Bosy et al. (USPN 6,598,303).

Regarding claim 8/2, Rozenkranc does not disclose the handle having ‘relieved surfaces’. Regarding claim 14, for the sake of argument, Rozenkranc may not disclose an oval finger pad.

Bosy et al. teaches an indent, or relieved portion, for providing access to finger gripping pad 24, figure 1 (column 2 lines 37-41 and column 3 lines 60-65). And a generally oval finger pad (24).

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc by making the finger pad oval and

indented as taught by Bosy et al, for added comfort. The motivation to combine is that having the finger pad be generally oval and indented (or have a relieved surface as seen in the figures) will be comfortable and allow access to the pad (“support multiple segments of an index finger”).

These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.

6. Claims 8/5 and 8/6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Gilder as applied to claims 5 and 6 above, and further in view of Bosy et al. (USPN 6,598,303).

Regarding claim 8/5, Rozenkranc in view of Gilder does not disclose the handle having ‘relieved surfaces’.

Bosy et al. teaches an indent, or relieved portion, for providing access to finger gripping pad 24, figure 1 (column 2 lines 37-41 and column 3 lines 60-65).

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc in view of Gilder by making the finger pad indented as taught by Bosy et al, for added comfort. The motivation to combine is that having the finger pad be indented (or have a relieved surface) will be comfortable and allow access to the pad (“support multiple segments of an index finger”).

These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.

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7. Claims 10/2, and 11/2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc as applied to claims 1 or 2 above in view of "Platinum Mach 14".

Rozenkranc does not disclose 4 or 5 or more primary shaving blades.

"Platinum Mach 14" discloses a 14 bladed razor (see figure on page two) .

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc by adding up to 14 primary blades as taught by "Platinum Mach 14". The motivation to use more blades, as stated in Coffin (USPGPUB 2003/0217469), is to "increase the shaving efficiency of the razor".

These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.

8. Claim 10/3 and 11/3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Gilder as applied to claim 3 above, and further in view of "Platinum Mach 14".

Rozenkranc does not disclose 4 or 5 or more primary shaving blades.

"Platinum Mach 14" discloses a 14 bladed razor.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Rozenkranc by adding up to 14 primary blades as taught by "Platinum Mach 14". The motivation to use more blades, as stated in Coffin (USPGPUB 2003/0217469), is to "increase the shaving efficiency of the razor".

These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.

9. Claims 2, 3, 5-11 and 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Braginetz (US 3,934,338) in view of Shurtleff et al. (5,687,485) and Kohring et al. (US D446,884 S).

Braginetz teaches a razor having a housing (figure 1) having a primary guard (68 on the left of figure 3) a cap at an upper surface of said housing (10 figures 3 and 4) one or more primary blades therebetween (see figure 3; the blades to the left are the primary blades); a trimming blade (15 a on the right of figure 3) oriented away from the upper surface and an elongated handle having a first end secured to the housing (75 figure 5, or 76, 77 figure 3, or both).

Braginetz does not teach a finger pad at the first end.

Shurtleff and Kohring both teach a finger pad (30 figures 1 and 2 of Shurtleff, all figures of Kohring), which is clearly at a “first end” of the razor handle. Shurtleff discloses that 30 is a “finger rest” column 6 line 66. Shurtleff also discloses “women like to place a finger on upper surface 20 of the razor to bear down on shaving unit 34 while shaving”. See also column 6 lines 22-28 describing the under curved portions (**the side that is on the same side as the primary shaving blades**) of the handle being alternative grips, stating “underside thumb support position ‘D’” (see D figure 6). It should be clarified that a Thumb is a finger, and the designation “thumb support” is the same as “finger support”. The Disclosure as a whole supports this position, since

numerous hand positions are described, and it clear that hand positioning is a matter of user choice. A support which is comfortable for a thumb is also comfortable for an index finger and given the numerous angles a user is attempting to shave, the user will change the positioning of a finger to best render comfort and control. The handle is also described as “comfortable” (column 2 line 53) and “ergonomic” (column 2 line 50). Shurtleff and Kohring both show that the handle is concave down on the same side as the blades (primary blades) especially in figures 4 and 6 of Shurtleff and figure 3 of Kohring. Shurtleff additionally discloses that the handle is relieved to allow access to the finger pad (column 6 lines 45 –50 discloses a finger channel which inherently is relieved proximal to the finger pad 30, figure 1). Shurtleff also clearly shows a bifurcation at a first end (all figures) enclosing a region therebetween (figure 8, at least). The region between the bifurcation is provided to provide access to the finger pad *at least* in the embodiment shown in figure 8 and described in column 7 lines 7-10. The finger pad of Shurtleff is seen to be “generally oval” as the term is best understood by Examiner- see figure 2.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Braginetz by using a handle having a bifurcated end with a finger pad at the first end, with relieved surfaces thereon, and a region enclosed by the bifurcation which provides access to the finger pad, the finger pad being positioned where the two portions join at the first end and the fingerpad being generally oval as taught by Shurtleff and Kohring. The motivation to combine is that the handle configuration as disclosed is comfortable and ergonomic.

Regarding claims 9-11, the recitation of additional blades is obvious, since it has been held that the mere duplication of the working parts of an invention to provide a magnified result is routine, common, not beyond the ordinary skill in the art, and capable of being accomplished by the skilled artisan. See St. Regis Paper Co. v. Bemis Co. Inc., 193 USPQ 8, 11 (7th Cir. 1977). Additionally, See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641 (Fed. Cir. 2006), which states that “the suggestion test is not a rigid categorical rule. The motivation **need not be found in the references sought to be combined**, but may be found in any number of sources, **including common knowledge**, the prior art as a whole, or **the nature of the problem itself**. *In re Dembiczak*, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997), ‘there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art.’ “ (emphasis added). The prior art as a whole renders obvious the addition of more blades, see for example the previously cited reference “Platinum Mach 14” which shows a 14 bladed razor. Additionally or In the alternative, the motivation to use more blades, as stated in Coffin (USPGPUB 2003/0217469), is to “increase the shaving efficiency of the razor”.

Claims 3, 5-11 and 13-15 (in the section above) stand or fall by their dependence on claim 2, as noted in the appeal brief.

10. Claims 7 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Braginetz (US 3,934,338) in view of Shurtleff et al. (5,687,485) and Kohring et al. (US D446,884 S) as applied to claims 2, 3, 5-11 and 13-15 above, and further in view of Rozenkranc (6,276,061) and Apprille Jr. et al. (US 5,787,586).

Braginetz (US 3,934,338) in view of Shurtleff et al. (5,687,485) and Kohring et al. (US D446,884 S) as applied to claims 2, 3, 5-11 and 13-15 above does not teach a pivotal connection with a rest stop.

Rozenkranc teaches a pivotal connection with a rest stop. (column 4 lines 64-67; also compare figures 2, 3 and 3a).

Apprille teaches a pivotal connection (all figures) between the housing and handle, and teaches that this is advantageous, since "housing 16 will pivot... and generally follow the contours of the user's face". This is desirable since it makes shaving easier.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Braginetz (US 3,934,338) in view of Shurtleff et al. (5,687,485) and Kohring et al. (US D446,884 S) as applied to claims 2, 3, 5-11 and 13-15 above by adding a pivotal connection between the handle and cartridge as taught by Apprille and Rozenkranc and to also provide a stop. The motivation to combine is that allowing pivotability will increase the ease of shaving generally (as taught by Apprille), and still allow for control while using the trimming blade (as taught by Rozenkranc).

Also in the alternative to the above rejection of claim 7, if the material of the fingerpad of Shurtleff is not determined to be “elastomeric”, elastomeric finger pad material is disclosed by Apprille et al. (element 40; column 3 line 45-50).

It would have been obvious to make the fingerpad out of elastomeric material as taught by Apprille since it is comfortable.

These claims stand or fall by their dependence on claims 2 and/or 3, as noted in the appeal brief.

(10) Response to Argument

Appellant argues the following:

A. On page 3 (4 including cover sheet) of the appeal brief submitted 12/21/2007, that the definition applied by the Office is “unconventional”. The definition that has been applied, as repeatedly and consistently stated by the Office is the **BROADEST REASONABLE INTERPRETATION OF THE CLAIM TERM**. Applicant has refused to provide an adequate definition to supplant the broadest reasonable interpretation, arguing that the word ‘end’ means ‘near the terminus’ or ‘near the terminal point plane or line’ ‘near the termination’ which is **indefinite** as repeatedly conveyed by the office, as in the non-final action dated 04/26/2007:

The terms “a first end” (claim 2 line 7; claim 3 line 7), “said first end” (claim 2 line 8, claim 3 line 8, claim 5 lines 1 and 2, claim 6 lines 1 and 2, claim 13 lines 1 and 2) and “the first end” (claim 15 line 2) are **indefinite**. The pad is (from the figures) located *near* the terminus, but not actually on the terminus of the handle, whereas the cartridge housing does connect at the actual terminus. Likewise in claim 3, the two portions do not join at the first terminus, they join adjacent the first

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terminus as seen in the figures. This divergent meaning (terminus versus near-terminus) reflected in the claim is indefinite. **Additionally**, the definition applicant is attempting to use for the word end ('near the terminus' or 'near the terminal point plane or line' "near the termination") is **indefinite** in and of itself, since one of ordinary skill in the art would not know whether a button lying at 5%, 10% or 20% constituted being "at a first end". Using the plain meaning 'near the terminus' renders the claim indefinite since **it fails to provide notice** to one of ordinary skill in the art what would infringe the claim as so construed. (emphasis added)

B. On page 4 (5 including cover sheet) of the appeal brief submitted 12/21/2007, that examiners construction of the terms "a first end", "said first end" and "the first end" is incorrect and Rozenkranc does not meet the limitations of the terms "a first end", "said first end" and "the first end". This allegation is false as supported by the following considerations:

The term meaning, as advanced by appellant, **is indefinite**. The pad is (from appellants figures; figures 15 and 16, labeled 726) located *near* the terminus, but not actually on the terminus of the handle. Additionally, the definition appellant is attempting to use for the word end ('near the terminus' or 'near the terminal point plane or line' "near the termination") is indefinite in and of itself, since one of ordinary skill in the art would not know whether a pad lying at 5%, 10%, 20% or any percentage up to the broadest reasonable definition of "less than, and not including half" constituted being "at a first end". Using the plain meaning 'near the terminus' renders the claim indefinite since it fails to provide notice to one of ordinary skill in the art what would infringe the claim as so construed.

Additionally, the finger pad in Rozenkranc is alleged by appellant to be "about half" of the length of the handle. As was pointed out previously, (Final action of 07/09/2007)

"the handle of Rozenkranc is a Gillette Mach 3 razor handle, and is not drawn to scale. I [Examiner] have personally measured a Gillette Mach 3 Handle, and the finger pad (as you, Gillette should know) starts much closer to the terminus having the primary blades than 45% as you continually allege. It is at the 20% mark that the finger-pad begins, which is unquestionably "at a first end" thereof. Your argument that the pad begins at the 45 yard line is misleading, and not in good faith."

It should additionally be pointed out that Appellant refused to answer a request for information regarding "models, exhibits, data or media" used in the drafting of the present application, which was included in the office action of 04/26/2007.

Appellant has stated that when the ball is resting on the "10 yard line", one team is "defending their end of the field". While this is true, the point made by examiner is that the term "end" equally applies when the ball rests on the 49 yard line, and the fact that **there is not any delineation between where the ball is considered to be "at an end" and where it no longer is, renders the claim indefinite.** Examiner was quite clear on this point in the action dated 04/26/2007, stating:

*"This divergent meaning (terminus versus near-terminus) reflected in the claim is indefinite. Additionally, the definition appellant is attempting to use for the word end ('near the terminus' or 'near the terminal point plane or line' "near the termination") is indefinite in and of itself, **since one of ordinary skill in the art would not know whether a button lying at 5%, 10% or 20% constituted being "at a first end"**. Using the plain meaning 'near the terminus' renders the claim indefinite since it fails to provide notice to one of ordinary skill in the art what would infringe the claim as so construed."*

Appellant has provided one example, and one "common" definition, stating "a football resting on the 10 yard line would be at one end of the field" and "a part or

place at or adjacent to an extremity” however these definitions do not set forth the metes and bounds of the claim. **Where** is the boundary to “at or adjacent to”. This is a broad claim, (which is acceptable) however when coupled with the severe vagueness of the terms “at or adjacent to” or the claim language itself “at a first end”, the claim is rendered indefinite. The examiner must ask the question, how will the claims be construed to one of ordinary skill in the art? Since the answer is that there is not a *consistent* definition, that persons having ordinary skill in the art could believe that the claim covered a pad up to 50% of the length of the handle, and would definitely not agree whether the “end” ended at 5%, 10%, 15%, 20%, 25%, 33%, or some other value, then appellant has not used language **necessary to establish what the metes and bounds of the claim are**, and the claims are therefore indefinite.

C. That “the Office Action relies on a separate member from the handle... to join the two portions of gilder's handle”, which is a factually false assertion. The Final office action of 07/09/2007), and the rejection above clearly state: “Gilder teaches a handle that is bifurcated such that there is a region between the two portions” (page 9 from the Final Action), and additionally on pages 19 and 20 that:

Gilder clearly, unquestioningly provides “a region between said two bifurcations. The bifurcated handle, **without any razor cartridge**, clearly, unquestioningly joins **at the first end**, where the two bifurcations touch (as in: where they split apart coming from the handle; or where they join when entering the handle) this is “at the first end”. **There is no requirement for a third side, for the region to be considered “enclosed” by the bifurcations.** There is an “enclosure” bounded between the bifurcations of the letter Y for example. Examiner reminds applicant that the

standard of claim interpretation during prosecution is as follows: “claims in a pending application should be given their broadest reasonable interpretation” consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the **specification***, which would then control. **Applicants arguments that claims which depend from claim 3 are also patentable** for the same reasons (that Rozenkranc in view of Gilder fail to establish prima facie obviousness) are **moot, without merit, and unpersuasive**.

D. That under heading 9 of the arguments section of the appeal brief of 12/21/2007 that “the finger rest 30 is on the opposite side of the primary blades”. This is true; however *the rejection* continues to say that

“See also column 6 lines 22-28 describing the under curved portions (**the side that is on the same side as the primary shaving blades**) of the handle being alternative grips, stating “underside thumb support position ‘D’” (see D figure 6). It should be clarified that a Thumb is a finger, and the designation “thumb support” is the same as “finger support”. The Disclosure as a whole supports this position, since numerous hand positions are described, and it clear that hand positioning is a matter of user choice.”

The rejection makes clear that “D” figure 6 of Shurtleff is a finger pad, clearly and unquestionably meeting the claim limitation “a pad[...] on the same side as said primary blades” (claim 2). This argument is clearly spurious, for at least the above reason. Additionally the duplication of parts is considered obvious to one of ordinary skill. If a person of ordinary skill were combining the handle of Shurtleff (for comfort)

with a bi-directional razor (for duality of use), it is apparent that a comfortable element would be placed on *both sides* of the handle. See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 80 USPQ2d 1641 (Fed. Cir. 2006), which states that “the suggestion test is not a rigid categorical rule. The motivation **need not be found in the references sought to be combined**, but may be found in any number of sources, **including common knowledge**, the prior art as a whole, or **the nature of the problem itself**. *In re Dembiczak*, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). As we explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997), ‘there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art.’ “ (emphasis added).

E. That there is “no motivation to modify Braginetz by using the handle of either Shurtleff or Kohring” (page 9 of appeal brief submitted 12/21/2007, including cover sheet, lines 1-2). This allegation is moot since The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007), 82 USPQ2d at 1396, foreclosed the argument that a specific teaching suggestion or motivation is required to support a showing of obviousness. See the Board decision *Ex parte Smith* –USPQ2d--, slip op at 20, (Bd. Pat. App. & interf. June 25, 2007). **Additionally**, appellant provides **no evidence** that “It would be nearly impossible to shave with both sets of opposing blades of the Braginetz cartridge as one set of blades would be at an extremely

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awkward angle...". In order to overcome the presumption of obviousness established by the Prima facie case evidence submitted must be of a nature and quality to overcome the prima facie case. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant...")(cited form MPEP 2107.02 VI). Also consider that statements which "merely express opinions, may be of limited probative value with regard to rebutting a prima facie case. *In re Grunwell*, 609 F.2d 486, 203 USPQ 1055 (CCPA 1979); *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991)." (cited form MPEP 2107.02 VI). For this additional reason the argument is considered unpersuasive.

Appellant alleges that the rejection of claim 3 by Braginetz, Shurtleff, and Kohring, and Rozenkranc and Apprille fails for the same reason that claim 2 is patentable over Braginetz, Shurtleff, and Kohring is moot in view of the fact that the rejection of claim 2 stands.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sean M Michalski/

Examiner, Art Unit 3724

/Kenneth E Peterson/

Primary Examiner, Art Unit 3724

Sean M. Michalski, AU 3724

Conferees:

/Allan N. Shoap/

/Boyer D. Ashley/

Allan N. Shoap, SPRE TC 3700

Boyer Ashley, SPE AU 3724